

REMARKS

Introduction

The present application has been studied and amended in view of the outstanding Office Action dated April 4, 2008, and reconsideration of that Action is requested in view of the following comments.

A petition for a one-month extension of time accompanies this response together with the appropriate fee. Accordingly, the deadline for responding to the Office Action has been extended until August 4, 2008, and this response is therefore timely filed since it was deposited in the mail for First Class Delivery Service on the date certified on the front page hereof.

Status of claims

Claims 1 to 10 have been examined on the merits.

Claims 1 to 6, 8, and 9 are currently amended. Claims 7 and 10 have been deleted, and claims 11 to 13 have been added.

The Office Action

Amendments of Claims; Rejections under 35 U. S. C., §§ 101 and 112

Claims 1 has been amended by deletion of the abbreviation "ABC" which has given rise to a lack of clarity. The same deletion has been made in claims 2 to 9. Claims 1 to 5 are directed to the reaction products of the hydroxy-functional binder components with compounds selected from the group consisting of **D'** and **D''**.

Claim 1 has further been amended by being directed to the reaction products originally claimed in claims 8 and 9, replacing the expression "the imide nitrogen atom being substituted by a hydroxy alkyl ... group" by "the imide nitrogen atom carrying a hydroxy alkyl ... group as substituent". This is the common understanding in organic

chemistry for the word substituent which refers to an atom or group that replaces a hydrogen atom in the core structure. See attached copies from "Wikipedia" for "Substituents" and "Substitution reaction". While the correct language in English is "substituted with" (see attached two pages from a recently granted US patent, the relevant text being highlighted) and not "substituted by" as the translation from the German language in this case has incorrectly put, it is clear for the person skilled in the art (an organic chemist) that a trivalent nitrogen atom cannot be "replaced" by a hydroxyalkyl group which is a monovalent group.

Claims 2 to 5 have likewise been amended and are directed to the reaction products originally claimed in claims 8 and 9. Claim 6 has been amended to include the reaction steps as recited in original claims 8 and 9.

In claims 8 and 9, the language "method of use" has been replaced by a claim directed to a process, and in claims 8 and 9, the (reaction) steps involved in the original method claims, viz. "esterifying" and "reacting", are worded as actions, and not by recitation of the substantive.

Further claims 11 to 13 have been introduced that are directed to a process of making the reaction products of claim 1, and taking up the wording of amended claims 6, 8, and 9.

No new matter has therefore been introduced, and entry of the amended claims is respectfully requested.

Rejection under 35 U. S. C. § 102 (b) and (e)

Claims 1 to 7 and 10 stand rejected as being anticipated by Patzschke GB 1,591,321. This reference discloses at page 5 a compound (formula I) that has two sorts of a cyclic imide structure, where the imide nitrogen atom of structure a) carries

a substituent Z which contains at least one basic nitrogen group, and the imide nitrogen atom of structure b) carries a substituent D which contains a hydrogen atom reactive with formaldehyde condensation resins or with masked isocyanates. Further, Patzschke discloses at page 4, bottom section, a cyclic imide structure where the imide nitrogen carries a substituent - (R)_n -OH. There is no substituent disclosed which carries an acid group, which is the condition per claim 1 for both **D'** and **D''**.

None of the substituents mentioned in Patzschke contains an acid group, as is particularly pointed out and distinctly claimed in claim 1, and all other claims depending upon claim 1, of the present application. Therefore, applicants deem that Patzschke fails to anticipate the subject matter as now defined in the amended claim set, and withdrawal of this reason of rejection is respectfully requested.

Claim 7 has also been rejected over Shirakawa US 2004/0197702. The rejection is moot as claim 7 has been deleted. However, in order to be fully responsive to this rejection, applicants submit that the substituent attached to the imide nitrogen atom, R²⁰⁶ - SO₂ - O-, does not contain an acid group as is mandatory per claim 1.

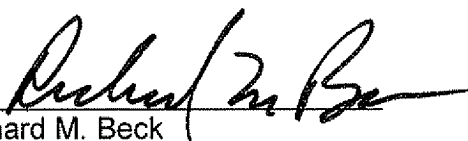
Therefore, also the rejection over Shirakawa under 35 U.S. C. 102 (e) is void.

There is also no teaching, suggestion, or motivation in any of the cited documents, or their combination, to use compounds selected from the group consisting of **D'** and **D''** each having an acid group, to react with a hydroxy-functional binder component that has a polymethylene structure -(CH₂)_n- or a polyester structure or a structure derived from fatty acid esters of glycerol or other polyhydric alcohols, where cyclic imide structures are grafted on the main chain, and where the imide nitrogen atom carries a hydroxyalkyl or hydroxyalkyl aryl group as substituent.

where cyclic imide structures are grafted on the main chain, and where the imide nitrogen atom carries a hydroxyalkyl or hydroxyalkyl aryl group as substituent.

It is therefore deemed that all reasons and arguments of the present Official Action have been properly dealt with, and that the subject matter of the instant application as now claimed is not anticipated nor made obvious by the cited art, and favorable reconsideration is respectfully requested.

Respectfully submitted,

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